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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/349,638	07/08/1999	DANIEL J. SHOFF	MS1-089USC1	6866

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EXAMINER
HUYNH, SON P

ART UNIT	PAPER NUMBER
2611	

DATE MAILED: 07/05/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

TR

Office Action Summary	Application No.	Applicant(s)	
	09/349,638	SHOFF ET AL.	
	Examiner	Art Unit	
	Son P Huynh	2611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *03* MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *08 July 1999* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *56-74* is/are pending in the application.

4a) Of the above claim(s) *58-60, 68-74* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *56,57 and 61-67* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on _____ is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☒ Other: *See Continuation Sheet* .

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

   I. Claims 56-57, 61-67, drawn to apparatus and method of receiving interactive TV program and launching an Internet browser, classified in class 725, subclass 112.

   II. Claims 58-60, 71-74, drawn to method of authorizing and presenting an interactive program with controlling the location and shape of the program boundary and presentation format, classified in class 725, subclass 47.

   III. Claims 68-70, drawn to method of creating data structure to organize programming with a target specification embedded in a data field, classified in class 725, subclass 36.

2. Inventions I, II and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, receiving interactive TV program and launching an Internet browser in invention I can be used in other system such as WebTV; authorizing and presenting an interactive program with controlling the location and shape of the program boundary and presentation format of invention II can be used in other system such as computer applications; creating data structure to

organize programming with a target specification embedded in a data field Invention III can be used in other system such as program production for use in advertisement. See MPEP § 806.05(d).

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with attorney Lewis C. Lee (Reg. No. 34,656) on 06/20/02 a provisional election was made with traverse to prosecute the invention of group I, claims 56-57,61-67. Affirmation of this election must be made by applicant in replying to this Office action. Claims 58-60, 68-74 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. The declaration filed on 07/08/1999 under 37 CFR 1.131 is sufficient to overcome the Hidary et al. (US 5,778,181) reference.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 61-67 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

"the program" and "the associated programs" in claim 61, 64-68 lack of antecedent basis.

Double Patenting

8. Claims 56-57, 61-67 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1,5-7,13-14 of U.S. Patent No. 6,240,555. Although the conflicting claims are not identical, they are not patentably distinct from each other.

Regarding claims 56 – 57, the claim limitations correspond to claim 1 of '555'. Claims 56 and 57 are broader in scope than claim 1 of '555'.

Regarding claim 61, the claim limitations correspond to claim 5 of '555'. Claim 61 is broader in scope than claim 5 of '555'.

Regarding claim 62, the claim limitations correspond to claim 6 of '555'. Claim 62 is broader in scope than claim 6 of '555'.

Regarding claim 63, the claim limitation is directed toward embody the method of claim 61 in a "computer programmed". It would have been obvious to embody the procedure of claim 5 or '555' discussed with respect to claim 61 in a "computer programmed" in order that the instruction could be automatically performed by a processor.

Regarding claim 64, the claim limitations correspond to claim 6 of '555'. Claim 64 is broader in scope than claim 6 of '555'.

Regarding claim 65, the claim limitations correspond to claim 13 of '555'. Claim 65 is broader in scope than claim 13 of '555'.

Regarding claim 66, the claim limitations correspond to claim 14 of '555'. Claim 66 is broader in scope than claim 14 of '555'.

Regarding claim 67, the claim limitations correspond to claim 7 of '555'. Claim 67 is broader in scope than claim 7 of '555'.

9. Allowance of claims 56-57 and 61-67 would result in an un-warranted time wise extension of the monopoly granted for the invention as defined in claims 1, 5-7, 13-14 of Patent No. 6,240,555; therefore, the double patenting rejection is justified.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

11. Claims 56, 61,63-66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Howe et al. (US 5,892,508), and in view of Palmer et al. (US 5,905,865).

Regarding claim 56, Howe et al. discloses a set top box for receiving and displaying continuous video content, comprising;

a memory 1230;

a processor programmed to determined whether the video content programs are interactive (Interactive Callback Address- ICA);
a tuner 1212 or 1218 to tune to channels carrying the video content programs; and an Internet browser 1234 for execution on the processor when the tuner is tuned to a channel carrying a video content programs that is interactive (see figure 8). However, Howe et al. fails to disclose the Internet browser being dynamically loadable for execution on the processor.

Palmer et al. discloses the Internet browser being dynamically loadable for execution on the processor (see col. 2, lines 18-24). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Howe et al. to provide an Internet browser being dynamically loadable for execution on the processor as taught by Palmer et al. in order to reduce the labor cost.

Regarding claim 61, the claim limitation of the method correspond to the claim limitation of the system being claimed in claim 56 and are analyzed as discussed in the rejection of claim 56.

Regarding claim 63, the claim limitation is directed toward embody the method of claim 61 in a "computer programmed". It would have been obvious to embody the procedure of Howe et al. in view of Palmer et al. discussed with respect to claim 61 in a

"computer programmed" in order that the instruction could be automatically performed by a processor.

Regarding claim 64, Howe et al. discloses a method for activating interactive supplemental content for a video program upon tuning to a channel carrying program comprising the steps of:
determining if the program is interactive by checking for the presence of ICA; and loading to the interactive server based on the ICA by selecting screen button (see figure 2B). However, Howe et al. fails to disclose the dynamically launching an Internet browser to activate the target recourse.

Palmer et al. discloses to disclose the dynamically launching an Internet browser to activate the target recourse. (see col. 2, lines 18-24). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Howe et al. of utilizing dynamically launching an Internet browser to activate the target recourse as taught by Palmer et al. in order to reduce the labor cost.

Regarding claim 65, Howe et al. in view of Palmer et al. discloses a system as discussed in the rejection of claim 64. Howe et al. further discloses the user selects the displayed button in order to access the interactive server (see figure 2B). Inherently, an icon to visually inform the viewer that the program is interactive compatible is displayed.

Regarding claim 66, Howe et al. in view of Palmer et al. disclosed a system as discussed in the rejection of claim 64, Howe et al. further discloses displaying the interactive supplemental content (interactive session) in response to the viewer activating the screen button (see figure 2B).

12. Claims 57, 62,67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Howe et al. (US 5,892,508) in view of Palmer et al. (US 5,905,865), and further in view of Miller et al. (US 5,585,866).

Regarding claim 57, Howe et al. in view of Palmer et al. discloses a system as discussed in the rejection of claim 56. However, neither Howe et al. nor Palmer et al. discloses storing an EPG in the memory and executable on the processor to organize program information.

Miller et al. discloses storing an EPG in the memory and executable on the processor to organize program information (see col. 20-37). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Howe et al. and Palmer et al. to stored EPG in a memory and executable on the processor to organize program information as taught by Miller et al. in order to utility of the system.

Regarding claim 62, Howe et al. in view of Palmer et al. discloses a system as discussed in the rejection of claim 61. However, neither Howe et al. nor Palmer et al. discloses checking the program listing to ascertain whether the program is interactive compatible; and determining that the program is interactive compatible by presence of a target specification being associated with the program in the program listing.

Miller et al. discloses checking the program listing to ascertain whether the program is interactive compatible; and determining that the program is interactive compatible by presence of a target specification being associated with the program in the program listing (see col. 8, line 20-col. 9, line 28). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Howe et al. and Palmer et al. by checking the program listing for interactive compatible and determining interactive compatible by presence of target specification as taught by Miller et al. in order to increase efficiency of the system.

Regarding claim 67, Howe et al. and Palmer et al. discloses a system as discussed in the rejection of claim 62. However, neither Howe et al. nor Palmer et al. discloses automatically displaying the interactive supplement content together with the interactive compatible program.

Miller et al. discloses automatically displaying the interactive supplement content together with the interactive compatible program (see figure 11). Therefore, it would

have been obvious to one of ordinary skill in the art at the time the invention was made to modify Howe et al. and Palmer et al. by automatically displaying the interactive supplement content together with the interactive compatible program as taught by Miller et al. in order to reduce the labor cost.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Lappington et al. (US 5,734,413) discloses inserting interactive information in the vertical blanking interval.

Wistendahl et al. (US 5,708,845) discloses system for allowing media content to be used in an interactive digital media program.

Menand et al. (US 5,563,648) discloses method for controlling execution of an audio video interactive program.

Sposato (US 5,781,228) discloses method and system for displaying an interactive program with intervening information segments.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Son P Huynh whose telephone number is 703-305-1889. The examiner can normally be reached on 8:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile can be reached on 703-305-4380. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the customer service office whose telephone number is 703-306-0377.

Son P. Huynh
July 1, 2002

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